

REMARKS

Claims 1, 2, 4 and 5 are now in the application. No new matter has been added by this Response.

Applicants appreciate the courtesies extended to Applicants' representative during the January 14, 2008 telephone interview. As agreed during the interview, the specification as filed complies with formal requirements. Applicants respectfully request that the objection to the specification set forth in the Office Action be withdrawn.

The Office Action asserts that the Declaration filed on July 19, 2005, fails to comply with formal requirements because it does not contain the title of the application. Applicants respectfully submit that the Declaration unambiguously identifies the title by specifying the application numbers of the priority documents. Thus, the Declaration complies with formal requirements.

Claims 1, 2, 4 and 5 are rejected under 35 U.S.C §112, second paragraph, because the claim feature "working up" recited in the pending claims is allegedly a relative term and, therefore, indefinite. Working up is a term of art that describes cleaning of an exhausted or deactivated catalyst to allow disposal. Further, the claim feature is described in detail in the specification. By way of non-limiting example, the specification, on page 2, lines 12-20, sets forth a detailed description of the process encompassed by the claim recitation "working up." In addition, the claim feature "working up" is also found in various U.S. Patents. Thus, the claim feature "working up" is described in the specification with reasonable clarity, deliberateness and precision, and, hence, complies with formal requirements.

Claims 1, 2, 4 and 5 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Mueller et al. (U.S. Patent No. 4,480,124) in view of Menger.

Claim 1 recites, among other features, purifying an at least partially deactivated hydrogenation catalyst comprising nickel, cobalt, iron, ruthenium, palladium, platinum or copper

by treatment with steam at from 100 to 250 °C and a gauge pressure of from 0 to 40 bar. As acknowledged in the Office Action, Mueller cannot reasonably be considered to suggest the combination of all of the features of independent claim 1. The Office Action relies on Menger for allegedly curing the deficiency of Mueller. The assertion in the Office Action fails for at least the following reason. Mueller cannot be modified by Menger as suggested in the Office Action because the proposed modification would render Mueller unsatisfactory for its intended purpose. Specifically, as set forth in MPEP §2143.01 V, “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” *In re Gordon*, 733F.2d 900 (Fed. Cir. 1984). Mueller is directed to the cationic polymerization of tetrahydrofuran, comprising treatment with hydrogen in the presence of a hydrogenation catalyst. By replacing hydrogen with water steam, as suggested in the Office Action, the intended purpose in Mueller of obtaining a low color number in the purification of polytetramethylene ether glycol could no longer be achieved. Thus, Mueller may not be combined with Menger and the rejection necessarily fails.

Further, Mueller is directed to an industrial process for the production of PTHF and PTHF diesters in which first a cationic polymerization in the presence of a polymerization catalyst yields PTHF or PTHF diesters. Subsequently, the polymerization products are purified by color number hydrogenation in the presence of a hydrogenation catalyst. To perform the polymerization a catalyst capable of polymerizing THF is required, commonly used in the art are catalysts with a lamellar silicate structure. To perform the hydrogenation a catalyst capable of hydrogenating PTHF or PTHF esters is required, the catalysts suggested in Mueller at col. 4, lines 9-13, are metal catalysts capable of binding hydrogen to the metal surface. See enclosed abstract from Wikipedia. However, Mueller does not suggest features that can reasonably be considered to correspond to a working up of the metal catalysts.

Menger suggests a process for working up at least partially deactivated polymerization catalysts for the polymerization of THF. The catalysts suggested in Menger, at col. 2, lines 29-51 are catalysts based on silicates. Menger fails to suggest features that can reasonably be

considered to correspond to working up of a hydrogenation catalyst. Thus, a combination of Mueller and Menger may be considered to suggest a working up of a polymerization catalyst used in the polymerization of the PTHF used in Mueller. Accordingly, even if the citations to Mueller and Menger are combined, the combination would not suggest a working up of a hydrogenation catalyst. Thus, the proposed combination in the Office Action fails to suggest the combination of all of the features of independent claim 1.

In view of the above, reconsideration and allowance are respectfully solicited.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 12810-00111-US from which the undersigned is authorized to draw.

Dated: February 19, 2008

Respectfully submitted,

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